

game result from a first game result from a first machine and a second game result from a second machine and setting the value based on the total game result." Because an action on the merits had previously issue in this application, claims 1-15 are deemed constructively elected, and claims 16-27 have accordingly been withdrawn from consideration, as being directed to a non-elected invention.

According to MPEP 808, "[e]very requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention *as claimed* is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons for insisting upon restriction therebetween as set forth in the following sections." Additionally, "in order to establish reasons for insisting upon restriction, [the examiner] must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of" (i) a separate classification, (ii) a separate status in the art, or (iii) a different field of search. Furthermore, MPEP 811 cautions that "[b]efore making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required."

The final Official Action fails to offer any "reasons why there would be a serious burden on the examiner if restriction is not required," or "show by appropriate explanation one of" (i) a separate classification, (ii) a separate status in the art, or (iii) a different field of search. Accordingly, it is respectfully submitted that the restriction fails to comply with the requirements of MPEP 808 and 811 on its face, and is therefore improper.

Further still, the final Official Action asserts that "[n]ewly submitted claims 16-27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 16 discloses a method for setting a value associated with an award obtainable based on a total game result from a first game result from a first machine and a second game result from a second machine and setting the value based on the total game

According to MPEP 802.01, to be independent the claimed inventions must be unrelated, "which means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect." On the otherhand, "[t]wo or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect. Examples of related inventions include ... process and apparatus for its practice ..."

Additionally, according to MPEP 802.01, "[r]elated inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art)."

According to MPEP 808.01, "[t]he particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. Furthermore, "[e]ach relationship of claimed inventions should be similarly treated and the reasons for the conclusions of distinctness or independence set forth." Additionally, "[w]here, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper.

Claim 14 (which depends for claim 1) requires a specification value determining device for determining a specification value, which comprises a big-hit shift probability, a payout, a payout rate, or a combination thereof, based on the data of a total game result achieved by the first gaming machine and the second gaming machine, and a specification value renewing device for renewing to replace the specification value with the specification value determined by the specification value determining device.

Thus, claim 14 discloses setting a value associated with an award

obtainable, such as a payout, based on a total game result from a first game result from a first machine and a second game result from a second machine and setting, by renewing to replace, the value based on the total game result.

It is respectfully submitted that, in view of the above, the inventions of, for example, claim 16 and claim 14 are clearly related as a process and apparatus for its practice, and therefore are not independent.

Furthermore, the Examiner's rationale for finding the inventions of claims 16 and 14 indistinct (i.e. because "[c]aim 16 discloses a method for setting a value associated with an award obtainable based on a total game result from a first game result from a first machine and a second game result from a second machine and setting the value based on the total game result") fails to provide any insight into basis on which it has been concluded that claim 14 or claim 16 "is PATENTABLE (novel and nonobvious) OVER THE OTHER" claim.

Accordingly, it is respectfully submitted that the restriction fails to comply with the requirements of MPEP 802 and 808 on its face, and is therefore improper.

In view of the above, it is respectfully submitted that the restriction (and hence the withdrawal) is improper for failing to comply with the mandates set forth in the MPEP. More particularly, in support of the restriction, the Official Action presents only a mere statement of conclusion, and not the required concise statement of the particular reasons relied on by the examiner for holding that the inventions as claimed are independent or distinct. As explicitly highlighted in the MPEP, a mere statement of conclusion is inadequate. Furthermore, the Official Action fails to present any reasons why insisting on restriction is necessary. More particularly, the Examiner fails to establish that the inventions of claims 1-15 and 16-27 require separate classification, have a separate status in the art, or require different fields of search.

Therefore, it is respectfully requested that the restriction and withdrawal of claims 16-27 be reconsidered and withdrawn.

Objection on Informality Grounds

Claims 1-27 stand objected to on informality grounds. The objection is respectfully traversed.

According to the Official Action, claims 1-27 are objected to because "functional recitation(s) using the word **"for"** (e.g. "for use"... as recited in claims 1-27) have been considered but given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue, Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method and system claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.). If Applicant(s) desire to give the phrase greater patentable weight, the Examiner respectfully recommends Applicant(s) remove "for use". Like always, such modification(s) must not constitute new matter and be supported in Applicant(s)' specification.

To overcome the rejection, Applicant is required to remove the "for" language and replace it by "that." For example: "*a first game machine that transmits/receives*". .. *and so on* ... Appropriate correction is required."

However, the referenced elements of claims 1-27 neither include "for use" language nor do they recite an "intended use" or "a purpose and intended result".

Indeed claims 11-14 are directed to a computer program and claim 15-27 are directed to methods. Hence, the basis of the objection with respect to these claims is entirely unclear.

Claims 1-10 recite structure defined by function, as apparently previously recognized by the Examiner, since only now, in the final Office Action, is the Examiner asserting that limitations first presented in the originally filed claims are directed to an "intended use" and therefore being given no patentable weight.

As highlighted in MPEP 2143.03 "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the

prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

As recognized in MPEP 2173.01 "[a] fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as **>any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01< Applicant may use functional language...or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought." Furthermore, "the fact that a particular mechanism...is defined in functional terms is not sufficient to convert a claim element containing that term into a 'means for performing a specified function' within the meaning of section 112(6). *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1786 (Fed. Cir. 1996) ("detent mechanism" defined in functional terms was not intended to invoke 35 U.S.C. 112, sixth paragraph). See also *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166-67 (Fed. Cir. 1999) (although the claim elements "eyeglass hanger member" and "eyeglass contacting member" include a function, these claim elements do not invoke 35 U.S.C. 112, sixth paragraph, because the claims themselves contain sufficient structural limitations for performing those functions)."

As further noted in MPEP2173.05(g) "[a] functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step...”

In the present application a recital such as “a specification value setting device for setting at least one specification value as a control condition for game control”, as presented in claim 1, recites a structural component defined by its function. That is, the required “setting at least one specification value as a control condition for game control” is a functional limitation on the capability of the specification value setting device. What claim 1 requires, and what those skilled in the art would clearly recognize claim 1 to require, is a specification value setting device capable of setting at least one specification value as a control condition for game control. There is no “intended use” of the specification value setting device, or any other recited structural component in claims 1-10, recited.

Accordingly, it is respectfully requested that the objection to claims 1-27 be reconsidered and withdrawn.

Obviousness

Claims 1-15 stand rejected under 35 U.S.C. 103(a), as obvious over Walker (US 6,110,041). The rejection is respectfully traversed.

The arguments presented in the prior response relating to the substantially identical rejection are hereby reasserted in their entirety.

In the Response to Arguments presented on page 6 of the final Official Action, it is asserted that “[a]pplicant’s arguments filed on 4/20/07 have been fully considered but they are not persuasive. Applicant argues that each of the independent claim requires ‘receipt or calculating of data of a total game result achieved by the first gaming machine and the second gaming machine, a determination of a specification value based on the total game result data, and

renewing to replace a set specification value with, or transmitting, the determined specification value.' In response to Applicant's arguments, most of the limitations in the claims include functional recitations using the word "for" and therefore carry no weight."

Thus, the Examiner has acknowledged that the functional limitations of claims 10-15 have been ignored. Accordingly, it is respectfully submitted that the rejection of claims 1-10 is improper on this basis alone.

Furthermore, it is apparent from the final Official Action that steps required to be performed by a computer directed by the programming of claims 11-14, and the process steps required by method claim 15 have also been ignored. Accordingly, it is respectfully submitted that the rejection of claims 11-15 is also improper on this basis alone.

Additionally, for the reasons discussed in the prior response referenced above, the applied prior art fails to teach or suggest the invention of claims 1-15 (or claims 16-27).

Accordingly, it is respectfully requested that the rejection of claims 1-15 be reconsidered and withdrawn, and that claims 1-27 be noticed for allowance.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

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To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No.1227.43224x00) and please credit any excess fees to such Deposit Account.

Respectfully submitted,
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